

REMARKS

- Claims 1 – 64, and 66 are currently pending in the present application.
- Of the pending claims, only claims 1, 55, 58 – 60, and 66 are independent.
- All claims stand rejected under 35 U.S.C. §103(a), albeit over different combinations of patents.

I. Claims 1 – 11, 13, 16 – 33, 49 – 52, 54 – 58 and 66

Claims 1 – 11, 13, 16 – 33, 49 – 52, 54 – 58 and 66 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,285,986 to Andrews et al. (“Andrews” herein) in view of U.S. Patent No. 5,970,469 to Scroggie et al. (“Scroggie” herein). Applicants respectfully traverse this rejection for the reasons set forth below.

I.(a). Claims 1 – 2, 28 – 29, 55 and 58

None of the prior art, alone or in combination, teaches or suggests the following feature that is recited in each of claims 1 – 2, 28 – 29, 55 and 58:

- *selecting, by an entity other than a buyer, a subset of the plurality of products for each of the product categories*

The above emphasized feature was already inherent in the claimed embodiments and Applicants have clarifyingly amended the claim to expressly recite the selection of products is performed by an entity other than the buyer.

Applicants are in agreement with the Examiner (Current Office Action, page 4, first full paragraph) that Andrews does not teach or suggest the above feature. However, Applicants respectfully disagree with the Examiner that Scroggie does teach the above feature.

The passages of Scroggie relied on by the Examiner (col. 9, lines 1 – 14; col. 9, line 41 – col. 10, line 4) as teaching the above feature, as well as the remainder of Scroggie, all clearly teach that a buyer selects product, coupons, recipes, etc. Scroggie does not even hint at an entity other than a buyer selecting a product, much less selecting subset of products for each of a plurality of product categories. Scroggie certainly does not teach an entity other than a buyer selecting a subset of products for each of a plurality of product categories, where an indication of the plurality of product categories was first received as part of buyer offer information that included an offer amount associated with the plurality of product categories.

In Scroggie, the consumer is completely in charge of selecting what products the consumer desires to purchase or receive offers for. See, for example, column 9, lines 60 – 61: “the final list will contain everything that the consumer has selected during the current session...”. (emphasis added). This is unlike the claimed embodiments, in which an entity other than the buyer selects products for the buyer from a plurality of product categories. Applicants have amended each of claims **1, 55 and 58** (the only independent claims in this group of rejected claims) to further emphasize this aspect of the claimed embodiments.

I.(b). No Motivation To Combine Provided

In addition to traversing the rejection of claims **1 – 2, 28 – 29, 55 and 58** on the grounds that the prior art does not teach or suggest all claim features, Applicants additionally traverse this rejection on the grounds that no motivation to combine the prior art in the manner suggested has been provided.

It is the burden of the Examiner to make particular findings in the record as to why one of ordinary skill in the art, without having the benefit of first having read Applicants’ disclosure, would have made the combination of references proposed.

No such findings have been provided for the rejection. Instead, the Examiner has merely asserted that each of the claim features is taught by one of the respective references, “[t]herefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method and apparatus of Andrews, to include the selecting a subset and providing an indication of the selected products and the receiving

of the indication from the buyer, as taught by Scroggie, in order to automatically sell and promote groups of products and services (Andrews col. 1, lines 28 – 29).” Current Office Action, page 4.

The above statement merely states that one of ordinary skill in the art would have been motivated to make the proposed combination because the combination would allegedly have resulted in the claimed combination and a desirable result would have been produced. Such reasons are not adequate to meet the Examiner’s burden. Particular findings of teachings in the references themselves, or within the knowledge of one of ordinary skill in the art, must be made that show why the combination would have been obvious. Bald statements of opinion, which basically state that the motivation to combine is that the elements of a claim are taught by various pieces of prior art and a desirable result will occur from the combination, are insufficient to meet Examiner’s burden. See, for example, the following excerpt from a Board of Appeals opinion:

“The examiner’s position can be stated basically to be that the modification of [the prior art reference] necessary to arrive at the claimed invention would have been obvious to the artisan because it would improve efficiency, performance, and reliability of the [prior art reference method]. While this result indicated by the examiner is undoubtedly correct, it is not a valid basis for the rejection of a claim. It explains more why appellant wishes to patent such a process. Since most inventions are designed to improve efficiency, performance or reliability, the examiner’s analysis would make it very difficult to patent anything.” (Ex Parte Bowen, Appeal No. 96 – 1349).

“‘The factual inquire whether to combine references must be thorough and searching.’ McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351 – 52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with....(“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”)....It is improper, in determining whether a person of ordinary skill would have been led to this

combination of references, simply to “[use] that which the inventor taught against its teacher.” In Re Lee, 227 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

Further, the statement of motivation to combine provided by the Examiner is insufficient to meet the Examiner’s burden of establishing why one of ordinary skill in the art would have made the proposed combination because the statement is a quote directly from Andrews of a result that Andrews itself states that it accomplishes. Since, upon reading Andrews, one of ordinary skill in the art would be taught that the Andrews system satisfies the purpose provided by the Examiner as the motivation to combine. In other words, one of ordinary skill in the art would not be motivated to modify the Andrews system in any manner to accomplish the purpose provided by the Examiner.

I.(c). Claims 3 – 11, 16 – 27, 30 – 33, 49 – 52, 54, 56 and 57 (each dependent from either claim 1 or claim 55)

Claims 3 – 11, 16 – 27, 30 – 33, 49 – 52, 54, 56 and 57 each include the claim features discussed in Section I.(a). and are thus patentable at least for the same reasons as claims 1 and 55 (also discussed in Section I.a.).

Additionally, Applicants respectfully disagree with the Examiner’s statement regarding claim 13, that Andrews discloses “receiving the buyer offer information from a buyer”. First, the Examiner is misstating the actual claim limitation. The claim limitation of claim 13, when read in the full context of the claim, is that “the indication of an offer amount comprises a buyer-defined offer amount” and that the offer amount is “associated with a plurality of product categories” and is included in “buyer offer information”. Andrews does not teach or suggest receiving buyer offer information that includes a buyer-defined offer amount that is associated with a plurality of product categories (as Applicants argued in the Response to the Previous Office Action). Andrews does teach receiving a bid from a buyer for a bundle of products. However, a bundle of products is a single product category under the Examiner’s interpretation. Andrews does not teach or suggest receiving a bid that is associated with a plurality of bundles or product categories.

Additionally, Applicants note that the Examiner is taking out of context, or not reading in its entirety, Applicants’ argument from the Response to the Previous Office

Action when the Examiner states “Applicant remarks that ‘Andrews does not teach buyer offer information’ and ‘receiving buyer offer information’.” Current Office Action, page 2.

Nowhere in the Response to the Previous Office Action did Applicants simply state that Andrews does not teach buyer offer information. In fact, Applicants acknowledged that Andrews teaches that “buyers can purchase a created bundle by paying the posted price for the bundle or bidding on the bundle.” Response to Previous Office Action, page 13.

Applicants went on to argue however, that Andrews does not teach receiving buyer offer information that includes an offer amount, where the offer amount is associated with a plurality of product categories. Response to Previous Office Action, page 17, first paragraph: “when a buyer indicates an interest in purchasing a bundle, any buyer offer information received is not associated with ‘the plurality of product categories’ as claimed in claims 1, 55, 58 and 60.” Applicants also argued that Andrews does not teach receiving buyer offer information if Examiner is interpreting “product categories” in a manner that the Examiner, in the Current Office Action, has clarified is not being used.

Regarding claim 13 (as well as claims 1, 55, 58 and 60), Applicants maintain that Andrews does not teach or suggest the claim feature of receiving buyer offer information, including an offer amount that is associated with a plurality of product categories.

I.(d). Claim 66 (independent)

None of the prior art, alone or in combination, teaches or suggests the following claim feature, which is recited in claim 66 as amended:

- *receiving an indication of selected products, the selected products comprising at least one product from each of the plurality of product categories and the selected products having been selected by an entity other than a buyer*

The above emphasized feature was already inherent in the claimed embodiments and Applicants have clarifyingly amended the claim to expressly recite that the selected products are products selected by an entity other than the buyer.

As discussed in Section I.(a)., neither Andrews or Scroggie teaches or suggests selecting, by an entity other than the buyer, a product or subset of products for each of a plurality of product categories. Accordingly, claim 66 is allowable over the prior art for the same reasons as claims 1,55 and 58.

II. Claims 12, 14 – 15, 34 – 39, 42 – 48, 60 and 63 – 64

Claims 12, 14 – 15, 34 – 39, 42 – 48, 60, and 63 – 64 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Andrews in view of Scroggie and further in view of U.S. Patent No. 6,401,080 to Bigus et al. (“Bigus” herein). Applicants respectfully traverse this rejection for the reasons set forth below.

II.(a). Claims 12, 14 – 15, 34 – 39 and 42 – 48

Each of claims 12, 14 – 15, 34 – 39 and 42 – 48 is dependent from claim 1. Accordingly, each of claims 12, 14 – 15, 34 – 39 and 42 – 48 includes the claim feature of “selecting, by an entity other than a buyer, a subset of the plurality of products for each of the product categories and is thus patentable at least for the same reasons as claim 1 (discussed above in Section I.(a)).

II.(b). Claim 60 (Independent)

None of the prior art, alone or in combination, teaches or suggests the following claim feature that is recited in claim 60 as amended:

- *selecting, by an entity other than a buyer, a subset of the plurality of products for each of the product categories*

The above emphasized feature was already inherent in the claimed embodiments and Applicants have clarifyingly amended the claim to expressly recite the selection of products is performed by an entity other than the buyer.

As discussed in Section I.(a)., neither Andrews or Scroggie teaches or suggests selecting, by an entity other than the buyer, a product or subset of products for each of a plurality of product categories. Bigus also does not teach or suggest such a feature. Accordingly, claim 60 is allowable over the prior art for the same reasons as claims 1,55 and 58.

II.(c). Claims 63 – 64 (each dependent from claim 60)

Claims 63 and 64 are each dependent from claim 60. Accordingly, claims 63 and 64 include the feature of “selecting, by an entity other than a buyer, a subset of the plurality of products for each of the product categories” and are patentable at least for the same reasons as claim 60.

II.(d). No Motivation to Combine Has Been Provided

In support of the combination of Scroggie, Andrews and Bigus, the Examiner has merely stated that “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention was made [sic] to modify the combination of Andrews and Scroggie to include the offers, as taught by Bigus, in order to provide a productive, adaptive, secure and efficient negotiations skills [sic] for conducting commercial transactions (Bigus col. 3, lines 42 – 45).” Current Office Action, bottom of page 7 – top of page 8.

This statement is insufficient to meet the Examiner’s burden of establishing a prima facie case of obviousness, for the same reasons discussed in Section I.(b).

Further, the statement of motivation to combine provided by the Examiner is insufficient to meet the Examiner’s burden of establishing why one of ordinary skill in the art would have made the proposed combination because the statement is a quote directly from Bigus of a result that Bigus itself states that it accomplishes. Since, upon reading Bigus, one of ordinary skill in the art would be taught that the Bigus system satisfies the purpose provided by the Examiner as the motivation to combine. In other words, one of ordinary skill in the art would not be motivated to modify the Bigus system in any manner to accomplish the purpose provided by the Examiner.

III. Claims 40 – 41 and 61 – 62

Claims 40 – 41 and 61 – 62 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Andrews, Scroggie, and Bigus in further view of U.S. Patent No. 5,905,975 to Ausubel (“Ausubel” herein). Applicants respectfully traverse this rejection for the reasons set forth below.

Claims 40 – 41 are each dependent from claim 1. Claims 61 – 62 are each dependent from claim 60. Accordingly, claims 40 – 41 include all of the limitations of claim 1 and are patentable at least for the same reasons as discussed with respect to claim 1 and claims 60 – 61 include all of the limitations of claim 60 and are patentable at least for the same reasons as discussed with respect to claim 60. Further, Ausubel, like Andrews and Scroggie, does not teach or suggest “selecting, by an entity other than a buyer, a subset of the plurality of products for each of the product categories”.

Applicants also traverse the rejection of claims 40 – 41 and 61 – 62 on the grounds that no proper motivation to combine the references has been provided. The statement provided by the Examiner on page 10 of the Current Office Action, that “[i]t would have been obvious...to modify the combination, to include the penalty, as taught by Ausubel, in order to avoid withdrawing of bids (Ausubel col. 30 lines 16 – 18)” is insufficient to meet the Examiner’s burden of establishing a prima facie case of obviousness for the reasons discussed above with respect to the other statements of motivations to combine provided by the Examiner.

The statement is also insufficient to establish a motivation to combine because, again, it is a direct quote from one of the references (Ausubel) of a purpose accomplished by that reference. Accordingly, one of ordinary skill in the art would not have been motivated to attempt to modify the reference in order to accomplish the purpose since the reference itself already states that it accomplishes the purpose.

IV. Claim 53

Claim 53 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Andrews and Scroggie in further view of U.S. Patent No. 5,890,136 to Kipp (“Kipp” herein). Applicants respectfully traverse this rejection for the reasons set forth below.

Claim 53 is dependent from claim 1. Accordingly, claim 53 includes the limitation of “*selecting, by an entity other than a buyer, a subset of the plurality of*

products for each of the product categories” and is patentable at least for the same reasons as claim 1. Kipp, like Andrews and Scroggie, does not teach or suggest the quoted claim feature.

Applicants also traverse the rejection of claim 53 on the grounds that no proper motivation to combine the references has been provided. The statement provided by the Examiner on page 10 of the Current Office Action, that “[i]t would have been obvious...to modify the combination, to include the taking possession of the selected products at a merchant, in order to pickup the article (Kipp col. 2, lines 24 – 25)” is insufficient to meet the Examiner’s burden of establishing a prima facie case of obviousness for the reasons discussed above with respect to the other statements of motivations to combine provided by the Examiner.

The statement is also insufficient to establish a motivation to combine because, again, it is a direct quote from one of the references (Kipp) of a purpose accomplished by that reference. Accordingly, one of ordinary skill in the art would not have been motivated to attempt to modify the reference in order to accomplish the purpose since the reference itself already states that it accomplishes the purpose.

V. Claim 59

Claim 59 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Andrews in view of Scroggie in further view of Bigus and in further view of Kipp. Applicants respectfully traverse this rejection for the reasons set forth below.

None of the prior art references, alone or in combination, teach or suggest the following claim features, which are recited in claim 59:

- *receiving from the buyer an indication of a first product category associated with a first set of products and a second product category associated with a second set of products; and*
- *selecting a first product from the first set of products and selecting a second product from the second set of products*

In other words, as in the other independent claims discussed above, the selection of products from a product category is performed by an entity other than a buyer. This is clear from the claim because the claim recites an entity receiving the indication of product categories from a buyer and then the same entity that receives this information from the buyer performs the step of selecting the products from the product categories. As discussed above, none of Scroggie, Andrews, Bigus or Kipp teach or suggest this feature.

Applicants also traverse the rejection of claim 59 on the grounds that no proper motivation to combine the references has been provided. The statements provided by the Examiner on pages 11 and 12 of the Current Office Action are insufficient to meet the Examiner's burden of establishing a prima facie case of obviousness for the reasons discussed above with respect to the other statements of motivations to combine provided by the Examiner.

VI. Conclusion and Petition for Extension of Time

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

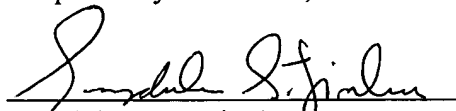
Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Magdalena M. Fincham at telephone number 203-461-7041 or via electronic mail at mfincham@walkerdigital.com.

Petition for Extension of Time to Respond

Applicants believe a one-month extension of time within which to respond to the Office Action is due with this response. Accordingly, Applicants petition for a one-month extension of time and authorize the charge of \$55.00 to our Deposit Account No. 50 - 0271. However, if an additional fee should be due, please charge it to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an extension of time is required, or if an additional extension of time is required in addition to that requested in a petition for an extension of time, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,



Magdalena M. Fincham
Attorney for Applicants
Registration No. 46,085
Walker Digital, LLC
mfincham@walkerdigital.com
203-461-7041 / voice
203-461-7300 / fax

January 13, 2004
Date

VI. Conclusion and Petition for Extension of Time

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

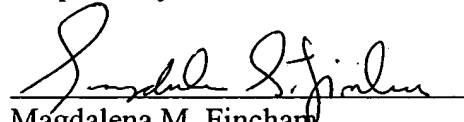
Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Magdalena M. Fincham at telephone number 203-461-7041 or via electronic mail at mfincham@walkerdigital.com.

Petition for Extension of Time to Respond

Applicants believe a one-month extension of time within which to respond to the Office Action is due with this response. Accordingly, Applicants petition for a one-month extension of time and authorize the charge of \$55.00 to our Deposit Account No. 50 - 0271. However, if an additional fee should be due, please charge it to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an extension of time is required, or if an additional extension of time is required in addition to that requested in a petition for an extension of time, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,



Magdalena M. Fincham
Attorney for Applicants
Registration No. 46,085
Walker Digital, LLC
mfincham@walkerdigital.com
203-461-7041 / voice
203-461-7300 / fax

January 13, 2004
Date